

Question Q217

National Group: Brazil

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The Brazilian IP law defines inventive activity as follows: “[a]n invention shall be considered as involving inventive activity whenever, for a person skilled in the art, it does not derive in an evident or obvious manner from the state of the art”.

Application of this standard in Brazil does not follow a formalized approach. Factors that weigh in favor of inventive activity include unforeseeable or surprising results, comparative data regarding the state of the art showing the superior performance of the invention, and the existence of a technical problem whose solution is desired for a long time and is achieved by the invention. Factors that weigh against inventive activity include the mere substitution of one known element for another and the mere juxtaposition of known means not resulting in a new technical effect.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

The standard was introduced in the Brazilian IP Law of 1996, which came into force in 1997. Before that, the Brazilian IP Code of 1971 did not expressly foresee the inventive activity requirement, which was defined in PTO internal rules as being “the exercise of creation

capability". While the IP Code of 1971 was in force, the concepts of "inventive activity" and "new or different technical effect" were usually mixed up.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes. The Brazilian PTO has published examination guidelines in 2002, in which it is taught that, upon analyzing inventive activity, one should consider whether a person skilled in the art, aware of the cited documents of the state of the art at the filing date (or the priority date, if any), would have been motivated to carry out the combination or modification needed to achieve the claimed invention.

The Brazilian Group believes that the guidelines could play a more useful and effective role in the examination of patent applications.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

Theoretically, the standard for inventive step/non-obviousness should be the same during examination and during litigation or invalidity proceedings. However, since the inventive activity is a subjective requirement, during litigation the analysis will depend on the arguments used by the parties and their interpretation by the Judge and his technical assistant. The opinion on inventive activity issued in the administrative phase may be reverted in a lawsuit against the PTO allowance or rejection decision.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

According to the Brazilian IP Law:

- "Claims shall be based on the specification, characterizing the particularities of the application and clearly and precisely defining the subject matter to be protected" (Art. 25);
- "The extension of the protection conferred by a patent will be determined by the content of the claims, interpreted in the light of the specification and drawings" (Art. 41);
- [Crimes against patents] "Supplying a component of a patented product, or material or equipment for carrying out a patented process, provided that the final application of the component, material or equipment necessarily leads to the exploitation of the subject matter of the patent" (Art. 185);
- "The crimes of this Chapter are committed even if the violation does not affect all the claims of the patent or if it is restricted to the use of means equivalent to the subject matter of the patent" (Art. 186).

The claims should be understood by a person skilled in the art based on the information provided in the specification, which shall describe the subject matter clearly and sufficiently so as to enable a person skilled in the art to execute it. The scope of the claims also includes equivalents to the claimed features and components/material/equipment which "necessarily leads to the exploitation of the subject matter of the patent".

6. Is it possible to read embodiments from the body of the specification into the claims?

According to the Brazilian IP Law, “[t]he extension of the protection conferred by a patent shall be determined by the content of the claims, interpreted based on the specification and drawings”.

Therefore, unless a certain embodiment was excluded from protection by post-filing amendments, in principle the specification should provide a basis from reading embodiments disclosed in the specification into the claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

The prior art should be interpreted by a person skilled in the art and reliance on inherent disclosures is permitted.

8. Do the answers to any of the questions above differ during examination versus during litigation?

Please refer to our response to item 4.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes, it is not unusual that Brazilian examiners issue objections related to lack of inventive activity based on a single prior art reference. They use to ground their opinion on common general knowledge, which can be refuted by the Applicant by presenting suitable counter-arguments.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

It is required that the publication dates of the prior art documents have been effected before the filing date or, where priority is claimed, the priority date of the application claiming the invention.

According to the examination guidelines published by the Brazilian PTO in 2002, upon analyzing inventive activity, one should consider whether a person skilled in the art, aware of the cited documents of the state of the art at the filing date (or the priority date, if any), would have been motivated to carry out the combination or modification needed to achieve the claimed invention.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

There is no specific examination guideline related to this subject matter.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes, it is. The standard is the same. In principle, the higher the number of documents cited to show the lack of inventiveness, the stronger would be the arguments to show that the claimed subject matter was not obvious, but there is no limit to the number of documents that would be applicable.

Remark: It is important to note that the Brazilian IP law foresees two kinds of patent protection: Patent of Invention, which has a twenty year term from the filing date (or ten years from granting, the longer), and Utility Model Patent, which has a fifteen year term from the filing date (or seven years from granting, the longer). According to the Brazilian IP law, inventions must meet the requirements of novelty, inventive activity and industrial application and utility models refer to an object of practical use, or part thereof, which it is susceptible of industrial application, presents a new shape or arrangement and involves an inventive act that results in a functional improvement in its use or manufacture. The requirement of Inventive act has an inventiveness/obviousness degree lower than that for inventive activity, but assuring a reduced period of protection.

13. Do the answers to any of the questions above differ during examination versus during litigation?

Please refer to our response to item 4.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

According to the examination guidelines published by the Brazilian PTO in 2002, the existence of a technical problem whose solution is desired for a long time and is achieved by the invention is one of the factors that weigh in favor of inventive activity.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

According to the Brazilian IP Law, the only requirement related to the specification is the “sufficiency of disclosure” or “enablement”, which means that a person skilled in the art should be able to execute the invention based on the subject matter disclosed in the specification.

However, the regulations (Normative Act 127/97, item 15.1.2(d) to (f)) provide that the specification shall:

- describe the state of the art as may be considered useful for understanding, search and examination of the invention, citing, whenever possible, the documents reflecting the same, pointing out the existing technical problems;
- define the objects of the invention and describe, in a clear, brief and precise manner, the proposed solution for the existing problem, as well as the advantages of the invention relative to the state of the art;
- point out, clearly, the novelty and bring to evidence the technical effect achieved.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

According to the examination guidelines published by the Brazilian PTO in 2002, comparative data regarding the state of the art showing the superior performance of the invention is one of the factors that weigh in favor of inventive activity. Actually, written opinions presently issued by the BPTO show a significant tendency to rely on comparative examples to a precise demonstration of advantageous effects.

17. Must the advantageous effects be disclosed in the as-filed specification?

As mentioned in the response to question 15, the regulations require that the specification bring to evidence the technical effect achieved. However, provided no new matter is added, we understand that this information also can be submitted by post-filing voluntary amendments.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, they can be submitted in a later on stage, for example, in reply to an office action, provided that they refer to illustrative data that would not represent addition of subject matter to the application text.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

There is no specific examination guideline related to this subject matter. However, results of actual experiments or tests tend to be more credible than non-tested hypothetical examples. The examiner has the discretion to decide whether hypothetical examples are disclosed in a sufficiently enabling manner.

20. Do the answers to any of the questions above differ during examination versus during litigation?

Please refer to our response to item 4.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

According to the examination guidelines published by the Brazilian PTO in 2002, one of the factors that weigh in favor of inventive activity is when the solution provided by the invention is contrary to normal activities in the same technical field and a person skilled in the art would not consider following the same direction. There is no specific guideline related to the explicitness of the “teaching away” information but, in practice, if a prior art document clearly indicates a solution that would lead someone skilled in the art away from the claimed invention, it is usually considered by the examiners.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

There is no specific examination guideline related to this subject matter.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

Please refer to our response to item 4.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

According to the examination guidelines published by the Brazilian PTO in 2002, one of the factors that weigh in favor of inventive activity is the commercial success of the claimed invention, when linked to its technical feature and not due to publicity or marketing. Failure of others to solve the problem is another factor that weighs in favor of inventive activity listed in the examination guidelines. A close connection between the claimed invention and the secondary considerations is required.

26. Do the answers to any of the questions above differ during examination versus during litigation?

Please refer to our response to item 4.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction? If yes, please describe these issues, tests, or factors.

There is no official procedure related to tests for inventive step/non-obviousness adopted by the Brazilian PTO aside from the tests or criteria already commented. The analysis does not follow a formalized approach.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

Please refer to the response to the previous question.

29. Does such test differ during examination versus during litigation?

Not applicable.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

Not applicable.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Please refer to our response to item 4.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Not applicable. Although the Brazilian PTO (INPI) is the only patent granting authority, the Brazilian National Agency of Sanitary Surveillance (ANVISA) has until recently performed a second substantive examination for patent applications in the pharmaceutical field following a decision from INPI to allow the application. However, an opinion recently issued by the Attorney-General's Office (AGU) has restricted the scope of ANVISA's interference in the patent granting process.

33. If yes, is this problematic?

Not applicable.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

The Brazilian Group understands that it would be desirable the harmonization as a manner of improving the ability of patent offices to share examination results

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

The Brazilian Group believes that from a juridical stand-point, yes. From a political stand-point having in mind the decades during which international substantive harmonization has been discussed, only hardly.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.